

07-20-07

IFW
AS/3624
#

TRANSMITTAL OF APPEAL BRIEF

Docket No.
51410/P013US/09900130

In re Application of: Peter Hartmaier

Application No. 09/365,426	Filing Date August 2, 1999	Examiner D. S. Felten	Group Art Unit 3624
-------------------------------	-------------------------------	--------------------------	------------------------

Invention: SYSTEM AND METHOD FOR PREPAID ACCOUNT REPLENISHMENT

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: May 19, 2004

The fee for filing this Appeal Brief is 330.00


☒ Large Entity ☐ Small Entity

☒ A check in the amount of 330.00 is enclosed.

☐ Charge the amount of the fee to Deposit Account No. _____
This sheet is submitted in duplicate.

☐ Payment by credit card. Form PTO-2038 is attached.

☒ The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 06-2380
This sheet is submitted in duplicate.


Michael J. Fogarty, III
Attorney Reg. No. 42,541
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8172

Dated: July 19, 2004

Appeal Brief Transmittal

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482736016US, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: July 19, 2004

Signature:  (Rita Carr)



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482736016US, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: July 19, 2004

Signature: Rita Carr

(Rita Carr)

Docket No.: 51410/P013US/09900130
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Peter Hartmaier

Application No.: 09/365,426

Confirmation No.: 1765

Filed: August 2, 1999

Art Unit: 3624

For: SYSTEM AND METHOD FOR PREPAID
ACCOUNT REPLENISHMENT

Examiner: D. S. Felten

APPELLANT'S BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief is in furtherance of the Notice of Appeal, filed in this case on
May 19, 2004.

The fees required under § 1.17(f) and any required petition for extension of time for
filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF
APPEAL BRIEF.

This brief is transmitted in triplicate.

07/22/2004 AWONDAF1 00000012 09365426

01 FC:1402

330.00 DP

This brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Invention
- VI. Issues
- VII. Grouping of Claims
- VIII. Arguments
- IX. Claims Involved in the Appeal
- Appendix A Claims

The final page of this brief bears the attorney's signature.

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Openwave Systems Inc., a Delaware corporation, having its principal place of business in Redwood City, California.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 16 claims pending in the application, which are identified as claims 12-15, 23, 29-32, and 34-40.

B. Current Status of Claims

Following entry of the amendments filed in the Amendment After Final Action dated January, 13, 2004, the status of the claims is as follows:

1. Claims canceled: 1-11, 16-22, 24-28, and 33.
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 12-15, 23, 29-32, and 34-40
4. Claims allowed: 15, 23, and 34-40
5. Claims rejected: 12-14
6. Claims objected to: 29-32

C. Claims Appealed

The appealed claims are: claims 12-14 and 29-32.

IV. STATUS OF AMENDMENTS

Appellant filed an Amendment After Final Rejection on January 13, 2004. The Examiner responded to the Amendment After Final Rejection in an Advisory Action mailed May 14, 2004. In the Advisory Action, the Examiner indicated that Appellant's proposed After Final Amendment filed January 13, 2004 would be entered and considered.

Accordingly, the claims enclosed herein as Appendix A do incorporate the amendments to claims 12-14 and 29-32, as indicated in the After Final Amendment filed January 13, 2004.

V. SUMMARY OF INVENTION

The invention allows prepaid customers to replenish a prepaid service account at various locations, such as retail locations, at Automated Teller Machines (ATMs), via the Internet or via a wireless telephone. One embodiment of the invention is system (101) for providing prepaid account replenishment. Replenishment system (101) provides

replenishment capability by serving as an interface between a bank (102) and a prepaid engine (103). (Specification, pg. 9, lns 1-5).

In one embodiment, the consumer receives a permanent prepaid account card that identifies the prepaid account. (Specification, pg. 9, lns 26-28). The account card is associated with a prepaid account at the replenishment system. (Specification, pg. 10, lns 7-10). The consumer may add value to the prepaid account at any location that is capable of conducting credit card transactions. (Specification, pg. 11, lns 5-7). When the customer needs to replenish his account, he may present the card at a retail outlet and indicate to the sales clerk that the transaction is a replenishment transaction. The user provides the clerk with cash or equivalent and the clerk then rings up the sale by swiping the prepaid card like a conventional credit card. (Specification, pg. 11, lns 7-16). The replenishment transaction is processed by a bank (102) connected to the retail location (104) and sent to the replenishment system (101) for authorization and confirmation. The user is then provided with a receipt indicating the amount of sale and a transaction number to confirm the transaction. (Specification, pg. 11, lns 20-28).

The transaction funds may remain in pending or revenue accounts at bank (102), and bank (102) will notify replenishment system (101) that the user has deposited a certain amount of funds that are to be credited to a particular prepaid account. (Specification, pg. 12, lns 8-12). Each transaction is processed by replenishment system (101) and is acknowledged after the information is stored in memory, such as a database. (Specification, pg. 12, lns 17-19). The replenishment service provider then updates the customer's prepaid account with the amount of replenishment and informs the customer of the replenishment within minutes of the initial transaction. (Specification, pg. 5, lns 14-20). The customer may then use the prepaid account balance to purchase services and products from participating merchants.

VI. ISSUES

The issues in the present appeal arise following the Examiner's failure to issue a Notice of Allowance following the Amendment After Final Action that was filed by Appellant on January 13, 2004. In the Final Office Action mailed November 19, 2003, the Examiner reasserted his previous rejection of claims 11-14, 27 and 28 and objection to claims 29-32. In the Office Action dated June 5, 2003, the Examiner had indicated that objected-to

claims 29-32 would be allowable if rewritten in independent form. The remaining claims in the application were either allowed or had been previously canceled.

In the Amendment After Final Action, Appellant rewrote objected-to claims 29-32 in independent form by incorporating the elements of base claim 11 into those claims. Appellant canceled claims 11, 28 and 29. Claims 12-14, which originally depended from base claim 11, were amended to depend from claim 29.

In the Advisory Action mailed May 14, 2004, the Examiner merely indicated that Appellant's amendments would be entered, but failed to update the status of the pending claims. Because the Appellant has canceled rejected independent claims and rewritten the objected-to claims in independent form, the pending claims are allowable over the prior art of record and a Notice of Allowance should be issued.

A. First Issue

The first issue is whether pending claims 12-14, as amended in the After Final Amendment filed January 13, 2004, are obvious under 35 U.S.C. § 103(a) in view of Taskett (WO 97/04579) (hereinafter *Taskett579*) and Taskett (WO 25237) (hereinafter *Taskett237*) in view of U.S. Patent No. 5,796,832 to Kawan (hereinafter *Kawan*) and U.S. Patent No. 5,590,038 to Pitroda (hereinafter *Pitroda*).

B. Second Issue

The second issue is whether pending claims 29-32, as amended in the After Final Amendment filed January 13, 2004, are objected to as being dependent upon a rejected base claim as indicated in the Office Action dated June 5, 2002.

VII. GROUPING OF CLAIMS

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below:

Group I	Claims 29 and 12-14
Group II	Claim 30
Group III	Claim 31

Group IV**Claim 32**

The claims do not stand or fall as a group. Appellant has included reasons for the separate patentability of each delineated group in Section VIII, Arguments, herein.

VIII. ARGUMENTS**A. Separate Patentability****Group I**

Group I includes claims 29 and 12-14. Claims 29 and 12-14 of Group III each require the following element in the step of communicating with a banking network regarding consumer replenishment transactions:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

verifying location identification information associated with received transaction messages, wherein said location identification information identifies authorized replenishment locations;

These elements clearly limit the requirements for the step of communicating with a banking network regarding consumer replenishment transactions by further defining the step of receiving transaction messages. Furthermore, it is possible for prior art to read upon a method of providing prepaid account services to consumers without reading upon a method of providing prepaid account services to consumers as claimed in claims 29 and 12-14 of Group I. Thus, Appellant submits that Group III is patentably distinct from the allowed claims.

Group II

Group II includes claim 30. Claim 30 of Group IV adds the following element to the step of communicating with a banking network regarding consumer replenishment transactions:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

verifying that permanent account numbers have been activated;

These elements clearly limit the requirements for the step of communicating with a banking network regarding consumer replenishment transactions by further defining the step of receiving transaction messages. Furthermore, it is possible for prior art to read upon a method of providing prepaid account services to consumers without reading upon a method of providing prepaid account services to consumers as claimed in claim 30 of Group II. Thus, Appellant submits that Group II is patentably distinct from Group I and the allowed claims.

Group III

Group III includes claim 31. Claim 31 of Group III adds the following element to the step of communicating with a banking network regarding consumer replenishment transactions:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

verifying that transaction identifiers associated with received transaction messages are not duplicates;

These elements clearly limit the requirements for the step of communicating with a banking network regarding consumer replenishment transactions by further defining the step of receiving transaction messages. Furthermore, it is possible for prior art to read upon a method of providing prepaid account services to consumers without reading upon a method of providing prepaid account services to consumers as claimed in claim 31 of Group III. Thus, Appellant submits that Group III is patentably distinct from Groups I and II and the allowed claims.

Group IV

Group IV includes claim 32. Claim 32 of Group IV adds the following element to the step of communicating with a banking network regarding consumer replenishment transactions:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

identifying transactions messages that are in variance with information contained in said reconciliation message;
and

logging said identified transaction messages in an exception file;

These elements clearly limit the requirements for the step of communicating with a banking network regarding consumer replenishment transactions by further defining the step of receiving transaction messages. Furthermore, it is possible for prior art to read upon a method of providing prepaid account services to consumers without reading upon a method of providing prepaid account services to consumers as claimed in claim 32 of Group IV. Thus, Appellant submits that Group IV is patentably distinct from Groups I, II and III and the allowed claims.

B. First Issue

The Examiner rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over *Taskett579* and *Taskett237* in view of *Kawan* and further in view of *Pitroda* in the Final Office Action dated November 19, 2003. Appellant traverses the rejection and asserts that claims 12-14, as amended in the After Final Amendment filed January 13, 2004, are allowable.

Appellant has amended claims 12-14 to depend from claim 29. As discussed in more detail below, claim 29 as amended is allowable and, therefore, dependent claims 12-14 are also allowable as they now depend from allowable claim 29.

C. Second Issue

The Examiner objected to claims 29-32 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. (See Office Action dated June 5, 2002 at page 6).

Appellant amended claims 29-32 by rewriting them in independent form to include all the subject matter of base claim 11. Thus, claims 29-32 have been amended according to the Examiner's suggestion, and therefore, claims 29-32, as amended, are allowable.

D. Conclusion

Appellant respectfully submits this Appeal Brief in furtherance of the Notice of Appeal, filed in this case on May 19, 2004. In addition, Appellant submits this Appeal Brief to avoid having this appeal dismissed and to have claims 12-14 and 29-32 indicated as allowed by the Examiner.

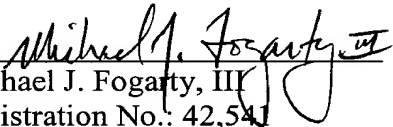
Furthermore, Appellant respectfully submits that Appellant has complied with all suggestions made by the Examiner in the Final Rejection dated November 19, 2003, by submitting appropriate amendments in the Amendment After Final Rejection dated January 13, 2004. Moreover, the Examiner responded to the Amendment After Final Rejection in the Advisory Action dated May 14, 2004, indicating that the Appellant's proposed amendments would be entered and considered. However, the Examiner has not yet submitted a notice of allowance or a new rejection. In addition, Appellant's Attorney (Andrew Vicknair, registration number 53,721) spoke with the Examiner on June 7, 2004, whereby the Examiner indicated that a notice of allowance for the pending application was likely to be issued as soon as the pending application was reviewed by a Supervisory Patent Examiner. Accordingly, Appellant respectfully requests that a notice of allowance be issued for the pending application.

IX. CLAIMS INVOLVED IN THE APPEAL

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Appellant in the After Final Amendment filed January 13, 2004.

Dated: July 19, 2004

Respectfully submitted,

By 
Michael J. Fogarty, III
Registration No.: 42,541
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8000
(214) 855-8200 (Fax)
Attorney for Appellant

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/365,426

1-11. (Canceled)

12. (Previously Presented) The method of claim 29 wherein said communicating with said prepaid engine further comprises the step of:

 sending a message indicating an amount to be added to a particular prepaid account.

13. (Previously Presented) The method of claim 29 wherein said bank is a banking institution.

14. (Previously Presented) The method of claim 29 wherein said bank is an entity that supports financial transactions over a point of sale network.

15. (Original) A method of providing prepaid account replenishment services comprising the steps of:

 receiving real time data from a bank, wherein said data comprises information related to a replenishment transaction;

 identifying a prepaid account number from said data;

 sending an update message to a prepaid engine, wherein said update message comprises information regarding an amount of money to be added to said prepaid account;

 receiving summary data from said bank, wherein said summary data comprises information related to a plurality of replenishment transactions;

 reconciling individual replenishment transactions by comparing said real time data with said summary data; and

 sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

16-22. (Canceled)

23. (Previously Presented) A method for replenishing prepaid accounts comprising the steps of:

receiving, at a voice response unit, calls from users desiring to replenish said prepaid accounts;

identifying each of said users;

prompting said users to select replenishment amounts;

processing replenishment transactions by causing the transfer of said replenishment amounts from a designated source account to said prepaid accounts;

prompting said users for a wireless telephone number; and

prompting said users for a personal identification number.

24-28. (Canceled)

29. (Previously Presented) A method of providing prepaid account services to consumers comprising the steps of:

- assigning prepaid accounts to said consumers;
- associating said prepaid accounts with wireless telephones;
- communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

- receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

- verifying location identification information associated with received transaction messages, wherein said location identification information identifies authorized replenishment locations;

- receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

- reconciling said individual transactions; and

- sending a message indicating the disbursement of funds associated with said replenishment transactions;

- communicating with a prepaid engine regarding said consumer replenishment transactions; and

- sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

30. (Previously Presented) A method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers;

associating said prepaid accounts with wireless telephones;

communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

verifying that permanent account numbers have been activated;

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

reconciling said individual transactions; and

sending a message indicating the disbursement of funds associated with said replenishment transactions;

communicating with a prepaid engine regarding said consumer replenishment transactions; and

sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

31. (Previously Presented) A method of providing prepaid account services to consumers comprising the steps of:

- assigning prepaid accounts to said consumers;
- associating said prepaid accounts with wireless telephones;
- communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

- receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

- verifying that transaction identifiers associated with received transaction messages are not duplicates;
 - receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;
 - reconciling said individual transactions; and

- sending a message indicating the disbursement of funds associated with said replenishment transactions;
 - communicating with a prepaid engine regarding said consumer replenishment transactions; and

- sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

32. (Previously Presented) A method of providing prepaid account services to consumers comprising the steps of:

- assigning prepaid accounts to said consumers;
- associating said prepaid accounts with wireless telephones;
- communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

- receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

- identifying transactions messages that are in variance with information contained in said reconciliation message; and

- logging said identified transaction messages in an exception file;
 - receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

- reconciling said individual transactions; and

- sending a message indicating the disbursement of funds associated with said replenishment transactions;

- communicating with a prepaid engine regarding said consumer replenishment transactions; and

- sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

33. (Canceled)

34. (Previously Presented) A system for replenishing prepaid accounts wherein real-time data is received from a bank, said real-time data comprising information related to a replenishment transaction and said data identifying a prepaid account, wherein the system comprises:

means for sending a message to a prepaid engine from a replenishment system, wherein said update message comprises information regarding an amount of money to be added to said prepaid account;

means for receiving summary data from said bank, wherein said summary data comprises information related to a plurality of said replenishment transactions;

means for reconciling individual replenishment transactions by comparing said real time data with said summary data; and

means for sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

35. (Previously Presented) The system of claim 34 wherein said bank is a banking institution.

36. (Previously Presented) The system of claim 34 wherein said bank is an entity that supports financial transactions over a point of sale network.

37. (Previously Presented) The system of claim 34 further comprising:
means for verifying location identification information associated with real time data from said bank, wherein said location identification information identifies authorized replenishment locations.

38. (Previously Presented) The system of claim 34 further comprising:
means for verifying that permanent account numbers have been activated.

39. (Previously Presented) The system of claim 34 further comprising:
means for verifying that transaction identifiers associated with real time data from said bank are not duplicates.

40. (Previously Presented) The system of claim 34 further comprising:
means for identifying replenishment transactions that are in variance with information contained in said summary data; and
means for logging replenishment transactions identified by said means for identifying into an exception file.